

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Robert Lee FITZSIMMONS, JR. Examiner: Mahmoud Fatahiyar

Serial No.: 09/881,216

Art Unit: 2629

Filed: June 15, 2001

Confirmation No.: 5137

For: **METHODS AND SYSTEMS FOR OPERATING A DISPLAY FACILITY OR
OTHER PUBLIC SPACE**

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Office Action dated December 22, 2006, the deadline for responding extending to March 22, 2006, the Applicant respectfully requests a review of the above-identified matter prior to filing an Appeal Brief. A Notice of Appeal is filed herewith under 37 C.F.R. § 41.31. No amendments are being filed with this request. Applicants submit that a review is appropriate at least because there are claim elements recited in the pending claims that have not been identified in the prior art cited by the Examiner.

The Applicant does not believe that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-1283.

ARGUMENTS

Introduction

Reconsideration of this Application is respectfully requested. Claims 21-25 and 27-41 are currently pending, with claims 21, 29 and 34-36 being the independent claims. Claims 21-25 and 27-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,169,498 to King et al. ("*King*") in view of U.S. Patent No. 6,009,410 to LeMole et al. ("*LeMole*").

To establish a *prima facie* case of obviousness by combining references, the Examiner must show sufficient motivation or teaching to combine or modify the references, a reasonable expectation of success resulting from the combination or modification, and that the references as combined teach all of the claim limitations. *See* MPEP § 2143. In this instance, the rejection is improper because Examiner has failed to establish a *prima facie* case of obviousness for at least the reasons that: 1) there has been no showing of sufficient motivation or teaching to combine *King* and *LeMole*, and 2) neither *King* nor *LeMole*, alone or in proper combination, suggest or disclose all of the claim limitations.

King and LeMole are not properly combinable

As discussed in the Applicant's Reply filed January 21, 2005 (see Page 6), and as further discussed herein, *King* and *LeMole* are combinable. *King* is directed to a portable device used to receive location-specific messages based on the presence of the portable device within a facility. *LeMole* is directed to a method of providing customized advertising via the World Wide Web to a user based on the user's demographic data and areas of interest. Although the Examiner states that both *King* and *LeMole* "have the capability to be connected to [the] [I]nternet," this high level relationship, by itself, is not sufficient to justify the combination of *King* of *LeMole*. More particularly, in the Final Action, the Examiner has not adequately described why one skilled in the art would be motivated to combine the facility-focused portable device of *King* with the web-based customized advertising arrangement of *LeMole*. Accordingly, in the absence of a suggestion to combine *King* and *LeMole*, either explicit or implied, this combination is not proper and must be withdrawn.

King and LeMole fail to disclose or suggest all of the claim elements

Even if King and LeMole are combined, they simply do not render the pending claims obvious. As discussed in the Applicant's Reply filed January 21, 2005, and as discussed further herein, neither *King* nor *LeMole*, alone or in proper combination, suggest or disclose all of the claim limitations. Although *King* discloses receiving an input from a user, *King* does not disclose or suggest associating any such input with the user. Rather, the input received is, at best, associated with the device from which the input is received, so that location-specific information can be transmitted to the device when the device is within the facility. See Col. 7, lines 6-13. Moreover, *King* is concerned solely with transmitting information within a facility and does not disclose or suggest transmitting information to a user when the user is outside of the facility.

Conversely, the concept of sending advertising as disclosed in *LeMole* is not based on an input received when "a visitor is in the public space," as recited in the independent claims. In fact, *LeMole* makes no reference to a public space, but rather discloses an information transaction that occurs solely via the Internet or via standard mail. See Col. 4, lines 36-39. Moreover, the advertising information transmitted in *LeMole* is not sent based on received input associated with a particular public space element, as recited in the independent claims. Rather, the targeted advertising is based on demographic data, subject areas of interest and/or previous websites visited, not a specific public space element. See Col. 4, lines 29-31 and col. 5, lines 32-34.

Accordingly, considering the separate nature of those communications occurring within a public space and those communications occurring outside of the public space, neither *King* nor *LeMole*, alone or in proper combination, disclose or suggest all of the elements recited in the claims. Moreover, in the Final Action, the Examiner did not identify with any specificity what portions of *LeMole* are directed towards the specific claim limitations analyzed herein, thus the rejection fails under 37 C.F.R. § 1.104 (c)(2), which requires:

When a reference is complex or shows or describes inventions other than that claimed by the applicant, *the particular part relied on must be designated as nearly as practicable*. The pertinence of each reference, if not

apparent, must be clearly explained and each rejected claim specified.
(emphasis added).

More particularly, unlike independent claim 21, neither *King* nor *LeMole*, alone or in proper combination, disclose or suggest “sending supplemental information to the visitor when the visitor is outside of the public space based on the received input . . .” wherein the received input is: 1) received when the visitor is in the public space, 2) relates “to one of the plurality of public space elements” AND 3) includes “a unique identifier associated with the visitor.”

Similarly, unlike independent claim 29, neither *King* nor *LeMole*, alone or in proper combination, disclose or suggest “receiving, within the public space, an electronic response . . . including . . . information associated with a piece of supplemental information from the one or more pieces of supplemental information and with address information related to the visitor.” Rather, *King* fails to disclose or suggest any communications including information to identify the user. As discussed above, the user profile disclosed in *LeMole* is not received within the public space visited by the user. Moreover, the user profile disclosed in *LeMole* is not associated with a piece of “supplemental information about at least one of the plurality of public space elements,” but is rather associated only with demographics and general areas of interest.

With regards to independent claim 35, as discussed above, neither *King* nor *LeMole*, alone or in proper combination, disclose or suggest a method that includes “associating visitor identification information with said electronic supplemental information selection,” wherein the electronic supplemental information selection is received “from the visitor in the public space.”

Similarly, unlike independent claim 36, neither *King* nor *LeMole*, alone or in proper combination, disclose or suggest a method that includes transmitting a response to “an electronic request for additional information from the visitor after the visitor has left the public space” wherein the response is based in part on input received “from a visitor while the visitor traverses the public space.”

Unlike independent claim 34, neither *King* nor *LeMole*, alone or in proper combination, disclose or suggest a system including a portable selection device, an internal information transmission system “configured to receive an input from the portable selection device, the input including a unique identifier associated with the visitor and an identifier associated with an element within the public space,” and an external information transmission system “configured

to send information included within [a] database from said database to the data network in response to the input received from the portable selection device and a request from the visitor when the visitor is outside of the public space."

Finally, the Applicant also respectfully submits that the rejections of dependent claims 22-25, 27, 28, 30-33 and 37-41 are improper, at least, because each of the respective independent claims from which these dependent claims depend includes elements not identified in *King* and *LeMole*, as discussed above.

Conclusion


The Applicant respectfully submits that, for at least the reasons stated above, the rejections under §103(a) are improper and claims 21-25 and 27-41 are allowable. Applicants respectfully request such a finding for the reasons set forth herein. Applicants would like to make clear that the arguments presented herein are merely those that are most appropriate for pre appeal brief review and are certainly not the only arguments related to patentability. Additional and more detailed arguments are expressly reserved for an Appeal Brief.

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Cooley Godward Kronish LLP
ATTN: Patent Group
1200 19th Street NW, Suite 500
Washington, DC 20036-2402
Tel: (703) 456-8000
Fax: (202) 842-7899

Respectfully submitted,
COOLEY GODWARD KRONISH LLP

By:


John R. Mills
Reg. No. 56,414